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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,995	07/30/2001	James S-B Spragins	SPRG1	9763

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,995

Applicant(s)

SPRAGINS, JAMES S-B

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to communications: Amendment filed 04/09/2005 to the original application filed 07/30/2001.
2. Claims 1-30 are currently pending in this application. Claims 1, 11, and 21 have been amended. Claims 1, 11, and 21 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 7-8, 10-13, 17-18, 20-23, 27-28 and 30 remain rejected under 35 U.S.C. 103(a) as being **Newbold et al.** (5,576,955 – issued 11/1996). Newbold was cited in the previously Office Action.

As to independent claim 1:

- a. Newbold teaches a method that enable one to give feedback on an electronic writing (*e.g., a document; col.2, line 8*) created with a word processing software (*e.g., word processing software; col.2, lines 12*) by another seeking the feedback and wherein the writing being displayable using the software on a video display

(e.g., display 10; col.3, lines 35-36) of a computer system (e.g., a computer system; col.2, lines 17-18), the method comprising the steps of:

- (i) developing a set of editorial markings that are insertable into the writing (e.g., once the text has been scanned and error units have been generated for the error detected during the scanning, the Error List is built; col.7, lines 64-66);
- (ii) selecting from the set of editorial markings a marking to be inserted into the writing (e.g., The proofreading functions are selectable from the Proofreading Screen ... the current error is located and highlighted in the text in the Text Window; col.8, lines 33-41);
- (iii) inserting the marking into the electronic writing (e.g., The message Window is filled with a descriptive message regarding the current error ... The most-likely correction in the first correction suggestion in the list of suggestion alternatives previously generated. CorrectWith is filled with the most-likely correction at processing block 406; col.8, lines 43-59) so as to create a version of said electronic writing that has inserted into said version at least of said insertable editorial markings (col.8, lines 42-54); and
- (ii) saving information pertaining to the inserted marking in the computer system (e.g., Learn adds the current word to the proofreading dictionary; col.5, lines 39-51)..

b. Newbold does not specifically teach “establishing a database.”

- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have applied Newbold's teachings to include "establishing a database" because it would have provided the ability to group errors. Thus, a more intuitive interface is provided to facilitate the proofreading exercise. Further, operator interaction is minimized and simplified.
- d. The fact that the Newbold's teachings "*the Proofreading Screen further provides the followings proofreading functions: Correct, Ignore, Learn, Undo, AutoCorrect, Disable, Done, ErrorList, and ErrorList Suggestions/Hide Suggestions ... Learn adds the current word to the proofreading dictionary*" (col.5, lines 38-51) and the purpose of adding the current word to the proofreading dictionary in Newbold suggests "establishing a database".

As to dependent claim 2:

Newbold teaches compiling summary statistics for the saved markings that communicate information pertaining to the use of the markings in the writing (*col.5, lines 38-51*).

As to dependent claim 3:

Newbold teaches filtering the inserted markings so that only a specified portion of such markings remain in the writing when it is returned to its writer (*col.10, lines 26-34 & item 256 in Fig.3 and item 434 in Fig.4C*).

As to dependent claim 7:

Newbold teaches chosen from the group consisting of information on the writing's punctuation, capitalization, italicization, grammar, word usage, content or form (*e.g.,*

addressing errors such as spelling, grammar, usage, punctuation, broken words, doubled words, and capitalization; Abstract / col.2, lines 11-21 & col.4, lines 16-29).

As to dependent claim 8:

Newbold teaches the compiled summary statistics communicate information selected from the group consisting of information pertaining to: (a) specified skills that the writer would need to focus upon in order to improve the writer's writing skills writer (*col.10, lines 26-34 & item 256 in Fig.3 and item 434 in Fig.4C*), (b) for a series of the writings by the same writer, the writer's progress towards improvement in those areas identified by the inserted markings as needing improvement, (c) for a collection of writings by a group of writers who are being instructed as a group, the group's general areas denoted by the inserted markings as needing improvement, and (d) for a series of writings by the group, the group's progress towards improvement in those areas identified by the inserted markings as needing improvement (*col.1, lines 54-62 / col.4, lines 8-29 & col.6, lines 52-67*).

As to dependent claim 10:

Newbold teaches the inserted marking having an associated editorial comment that is insertable in the writing (*Abstract/ col.2, lines 6-20 and col.8, lines 43-59*).

As to independent claim 11:

It is directed to a computer program product for implementing the method of claim 1, and is similarly rejected under the same rationale.

As to dependent claims 12-13, 17-18, and 20:

They include the same limitations as in claims 2-3, 7-8, and 10, and are similarly rejected under the same rationale.

As to independent claim 21:

It is directed to a system for implementing the method of claim 1, and is similarly rejected under the same rationale.

As to dependent claims 22-23, 27-28, and 30:

They include the same limitations as in claims 2-3, 7-8, and 10, and are similarly rejected under the same rationale.

5. Claims 4-6, 9, 14-16, 19, 24-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Newbold** in view of **Driscoll et al.** (5,987,302 – issued 11/1999). Driscoll was cited in the previously Office Action.

As to dependent claims 4-6, 14-16 and 24-26:

- a. Newbold does not explicitly teach “hyperlinking the inserted marking to a website that exists on a network of linked computers.”
- b. Driscoll teaches hyperlinking the inserted marking to a website that exists on a network of linked computers (*col.3, lines 8-10; col.7, lines 34-54; col.9, line 66- col.10, line 14*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature Newbold in the system of Driscoll because it would have provided the capability for offering students the

opportunity to prepare practice essays, submit the essays to trained, expert readers, and retrieve an evaluation at the student's convenience.

As to dependent claims 9, 19 and 29:

- a. Newbold does not explicitly teach "the website having information chosen from the group consisting of detailed explanations of the markings and exercises that one can undertake in order to strengthen those writing skills which are denoted by the inserted markings as representing areas in which the writer needs improvement."
- b. Driscoll the website having information chosen from the group consisting of detailed explanations of the markings and exercises that one can undertake in order to strengthen those writing skills which are denoted by the inserted markings as representing areas in which the writer needs improvement (*col.4, lines 47-65/ col.6, line 50 – col.7, line 1*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the feature Newbold in the system of Driscoll because it would have provided the capability for providing useful instructional feedback to students about their skills relative to the assessment or test that the student wishes to take.

Response to Arguments

6. Applicant's arguments filed 04/09/2005 have been fully considered but they are not persuasive.
 - a. Applicant argues that *Neither the cited portion, or any other portion, of Newbold discloses "inserting an editorial marking into the original electronic writing thereby creating an effective new version of the original electronic writing that has inserted into it editorial markings – a version which can be returned to author of the original electronic writing to give him/her feedback, which he/she can use as they like to make any desired changes to his/her electronic writing."* (Remarks, page 10, 1st full para.)

In response, Applicant is arguing the disclosure of the invention, not the claimed limitations. Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. See In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978). The Examiner has a *duty* and *responsibility* to the public and to Applicant to interpret the claims *as broadly as reasonably possible* during prosecution (see *In re Prater*, 56 CCPA 1381, 415 F.2d 1393, 162 USPQ 541 (1969).

Applicant does not specifically claim *"inserting an editorial marking into the original electronic writing thereby creating an effective new version of the original electronic writing that has inserted into it editorial markings – a version which can be returned to author of the original electronic writing to give him/her feedback, which he/she can use as they like to make any desired changes to his/her electronic writing"*.

- b. Applicant argues that *means for inserting said marking into said electronic writing can not be found in Newbold*. (Remarks, page 10, 2nd full para.)

In response, Newbold's teachings *"The message Window is filled with a descriptive message regarding the current error ... The most-likely correction in the first correction suggestion in the list of suggestion alternatives previously generated. CorrectWith is filled with the most-likely correction at processing block 406"* (col.8, lines 43-59) meet the limitations as broadly claimed by Applicant.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mehlenbacher et al., "Active and Interactive Learning Online: A Comparison of Web-Based and Conventional Writing Classes, IEEE Transactions on Professional Communication, Vol.43, No.2, June 2000, pp.166-184.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am - 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/6/2005